

REMARKS

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. Claims 1, 2, 12, 13, 21, 23-25 and 27 have been amended. Claim 22 has been canceled. No claims have been added. Thus, claims 1-7, 12-21, 23-28 and 31-46 are pending.

Claim Objections

Applicants acknowledge the claim numbering error in a previous response identified in the Final Office Action mailed November 18, 2002. The claims in this Response are numbered according to the numbering set forth in the Final Office Action. Therefore, Applicants request that the objection to the claims be withdrawn.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-7, 12-28 and 31-46 were rejected as being unpatentable over U.S. Patent No. 6,167,446 issued to Lister, et al. (*Lister*) in view of U.S. Patent No. 5,828,830 issued to Rangaraian, et al. (*Rangaraian*). Claim 22 has been canceled without prejudice. Therefore, the rejection of claim 22 is moot. For at least the reasons set forth below, Applicants submit that claims 1-7, 12-21, 23-28 and 31-46 are not rendered obvious by *Lister* and *Rangaraian*.

Claim 1 recites:

requesting, with a local device, configuration services from a remote device coupled to the network in response to connecting the local device to the network;

providing configuration services, with the local device, to one or more remote devices of said network if the response to said configuration information request is not received by the local device from said remote device within a predetermined period of time;

providing configuration services, with the local device, to one or more remote devices of said network if said local device has a higher priority than said remote device; and

receiving configuration services from said remote device with the local device as a client device if said remote device has a higher priority than said local device.

Thus, Applicants claim requesting configuration services with a network device and if configuration services are not available to the device providing configuration services with the device. That is, the device provides configuration services if a response is not received or if the device has a higher priority than responding devices and the device receives configuration services if the device has a lower priority than the responding device.

Lister is directed to a network proxy cache that ***provides*** tracking of names. See, for example, the Summary of the Invention. Specifically, *Lister* states:

The present invention provides automatic configuration for proxy caches such as network-infrastructure caches.

See col. 3, lines 39-40. *Lister* does not disclose a device that ***selectively provides or receives configuration services*** and can operate as a client device. The device discloses by *Lister* provides name services at all times. The device does not receive configuration services under any condition. Therefore, *Lister* cannot teach or suggest the method as set forth in claim 1.

Rangaraian is cited merely to disclose comparing priorities. *Rangaraian* specifically discloses prioritization and filtering of network traps. See Abstract. *Rangaraian* does not address selectively providing configuration services. Therefore, *Rangaraian* does not cure the deficiencies of *Lister*. Because neither *Lister* nor *Rangaraian* disclose a device that provides configuration services under certain

conditions and receives configuration services under other conditions, no combination of *Lister* and *Rangaraian* can teach or suggest the invention as claimed in claim 1.

The Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to determine the priority of devices connected to the network in order to identify the appropriate states of devices in the network ***before making decision of whether or not necessarily to provide configuration service.***

See page 3 (emphasis added). Whether or not this statement is true, the Office Action still fails to address selectively providing *or* receiving configuration services with a single device. Thus, even following the modifications and suggestions set forth in the Office Action, *Lister* and *Rangaraian* would not result in the invention as claimed in claim 1.

Moreover, to establish *prima facie* obviousness, the Office Action must show that there is some motivation, suggestion or teaching of the desirability of the combination of references proposed in the Office Action. See *In re Kotzab*, 55 USPQ 2d 1313 (Fed. Cir 2000). The motivation provided in the Office Action of November 18, 2002 fails to meet the requirements set forth in *Kotzab*. Therefore, the Office Action fails to provide a *prima facie* case of obviousness.

Because *Lister* fails to disclose a device that provides or receives configuration services and *Rangaraian* does not even disclose remote configuration services, the combination of *Lister* and *Rangaraian* can only be made using hindsight reconstruction.

It is well settled that

[i]t is impermissible within the framework of § 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such a reference fairly suggests to one of ordinary skill in the art.

In re Wasselau, 147 U.S.P.Q. 391, 393 (C.C.P.A 1965).

Applicant respectfully contends that the combination of *Lister* and *Rangaraian* could only have been accomplished through carefully considered hindsight using Applicant's claims as a reconstructive guide. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art in order to render the claimed invention obvious. In re Fritch, 972 F. 2d 1260, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992). Based on the foregoing, Applicants request that the rejection of claim 1 as being unpatentable over *Lister* and *Rangaraian* be withdrawn.

Claims 2-7 depend from claim 1. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 2-7 are not rendered obvious by *Lister* and *Rangaraian* for at least the reasons set forth above.

Claim 12 recites:

determining service capability of said local device including whether said local device is capable of providing configuration services to one or more remote devices of said network;

providing configuration services to one or more devices from the local device of said network if configuration services are not provided by a network device having a higher priority than said local device; and

operating the client device as a client device to receive configuration services from a remote device if said remote device has a higher priority than said local device.

Thus, Applicants operating a local device to selectively either provide configuration services or to receive configuration services. Claims 21 and 26 similarly recite determining which of multiple devices provides configuration services. New claims 31 and 38 are means plus function claims that similarly recite determining which of multiple devices provides configuration services.

As discussed above, not combination of *Lister* and *Rangaraian* teaches or suggests operating a device, or a device itself, to provide configuration services under a first set of conditions and to receive configuration services under a second set of

conditions. Therefore, no combination of *Lister* and *Rangaraian* can teach or suggest the invention as claimed in claims 12, 21 and 26.

Claims 13-20 depend from claim 12. Claims 22-25 depend from claim 21. Claims 27 and 28 depend from claim 26. Claims 32-37 depend from claim 31. Claims 39-46 depend from claim 38. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 13-20, 22-25, 27, 28, 32-37 and 39-46 are not rendered obvious by *Lister* and *Rangaraian* for at least the reasons set forth above.

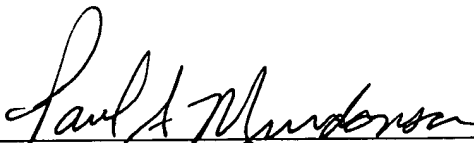
Conclusion

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1-7, 12-21, 23-28 and 31-46 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: FEB 19, 2003



Paul A. Mendonsa
Reg. No. 42,879

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(503) 684-6200